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EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2164

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/439,343

Applicant(s)

DIRIENZO, ANDREW L.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9, 10, 29-32, 35, 39-44, 48-64, 70-93, 103-108, 112, 113 and 125-127 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 10, 29-32, 35, 39-44, 48-64, 70-93, 103-108, 112-113, 125-127 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
PRIMARY EXAMINER

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 103-108, 112-113 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 103: Claim 103 has been amended to recite “..wherein each of the links is associated with a single one of the digital information blocks.” This feature is not taught or supported in the original specification. The only discussion of relations between links and information are set forth at pages 26 and 27.

The first two lines of page 26 state:

*“Within the RAMIX Clearing House Computer are located Patient Bid Queues (PBQs) which contain a pointer or link to patient electronic medical images.”* (underlining added).

The first three lines of page 27 state:

*“The RAMIX system and operating method according to the present invention advantageously would include Physician Mail Boxes, which stores links, i.e. pointers to electronic medical images (EMIs) arranged in fee amount order..”* (underlining added).

*In each quote, the pointer is demonstrated as being linked to plural electronic images. In order to support the cited claim language, the specification would have to define the information block as being the plural images. However, since the specification never invokes or otherwise*

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*defines the term "information block", and since distinct plural images would only suggest plural information blocks, the disclosure only suggests a link to plural information blocks, not a link to a single information block. Accordingly, the claimed feature is new matter.*

Claims 104-106: Depend on claim 103.

Claim 107: Same rationale for rejection a claim 103.

Claims 108, 112, and 113: Depend on claim 107.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, 10, 29-31, 35, 39-44, 48-58, 60-64, 70-76, 79-87, 89-93, 125 and 127 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverman et al. (U.S. Patent 5,136,501).

Claim 1: Column 2, lines 17-21 refers to a database of trading instruments available for trade between first and second users. These trading instruments are digital information blocks stored in buffer memory. Each of the digital information blocks includes an indicia of priority, which is either a bid or an offer (See FIG. 4). The digital information blocks are traded between first and second users (client keystations, 24a, 24b). As seen in FIG. 5, a client keystation book only receives and displays a subset or selected number of blocks (col. 10, lines 2-5), in comparison to the central book of FIG. 4 which receives and displays all the blocks. The

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establishment of a keystation book (FIG. 5) for a client is thus an election to receive certain information blocks and the selected blocks are those which are displayed. At least block is displayed, so at least one block is selected.

Claim 3: As seen in FIG. 16, users can change the indicia by canceling the indicia. A user can also change the indicia by making multiple offers of multiple bids.

Claim 9: The indicia may be an ask price (FIG. 4).

Claim 10: The ask price is suggested by one of the users. It is not generated automatically.

Claim 29: Silverman et al. discloses a first computer system (one of the keystation books of FIG. 5); a second computer system (central station book of FIG. 4) and a third computer system (one of the keystation books of FIG. 5). Each of the computer systems include memory and operating instructions and are linked together by communications channels. Each of the computer systems receives work order packages, which are the blocks, such as 73-77 illustrated in FIG. 4. Each work order package includes a work order summary (value for the package, such as "138.86" in block 73) and work order (primary quantity for the package, such as "5.0" in block 73). When a bid or offer is placed by one of the bidding or offering parties, the blocks show the data for the work order and work order summary as being parsed (separated within the block). The order of the packages shown on any of the computer terminals is based upon the value of the work order summary. If the work order summary value is, for example, "140.05" (block 100 in Fig. 4), it is the highest value and appears at the highest level in the hierarchical order displayed by the computer terminals. Any change in these indicia would result in a re-ordering of the blocks. Work orders can be singled out at the client keystation book of FIG. 5,

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where only a subset of blocks are displayed in comparison to the central keystation book which displays all the blocks. At least one block is shown in Fig. 5.

Claim 30: Communications channels link each of the three computer systems together. Any given communications channel can be arbitrarily designated as “low speed” or “high speed” since the claims do not indicate what parameters distinguish the “low speed” from “high speed”.

Claim 31: Each of the electronic books illustrated in FIGS. 4 or 5 can be read as “memory queues”.

Claim 35: See remarks for claim 29. Note that the system of Silverman et al. facilitates interactive bidding between multiple parties and functions as an electronic marketplace for the distribution of data to multiple parties.

Claim 39: The digital information blocks are trading instruments in a database (col. 2, lines 17-21). The digital information blocks are ordered within a database. The blocks may be represented by graphic indicators (any of the boxes, lines or indicia in FIG. 4). The indicia of priority is the bid or offer (ask) price. As seen in FIG. 5, client keystation will selectively display only a subset of the blocks, thus selectively single out for receipt only certain blocks derived from master keystation book of FIG. 4.

Claims 40-41: The indicia of priority is the bid or offer (ask) price.

Claim 42: The graphic indicators include both numbers and letters.

Claim 43: FIG. 4 illustrates statistical measures, such as blocks for best offer value and best bid. Value.

Claim 44: The statistical measures are represented graphically, by a graphical user interface.

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Claim 48: As seen by comparing FIGS 4-5, the statistical information (best offer value and best bid value) is displayed at only the central station, and thus is presented to only one of the users.

Claim 49: The total number of users may inherently be represented by the total number of blocks when all the users are bidding.

Claim 50: In FIG. 4, each block represents a displayed transaction.

Claim 51: IN FIG. 16, original offers that are cancelled are represented as large hash marks.

Claim 52: As seen in FIG. 4, the indicia are ordered into separate queues. Indicia representing bids are on the left queue. Indicia representing offers are on the right queue.

Claim 53: The graphic indicators in FIG. 4 are ordered according to the time they were received (see right and left pointing arrows at top).

Claim 54: The graphic indicators in FIG. 4 are further ordered according to additional information, namely, the absolute value of price.

Claim 55: The graphic indicators (boxes) are considered to be “links” since they derive from data within a database, and are linked to the data within the database.

Claim 56: FIG. 17 illustrates highlighted graphical indicators (boxes containing “139.19”).

Claim 57: Each user has a graphical user interface that is fully visible to that user. Each graphical user interface can present information that is generated by one of the users.

Claim 58: Any number illustrated in FIG. 4 reads as a document control number.

Claim 60: See remarks for claim 55.

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Claim 61: The blocks of FIG. 4 are constantly re-ordered as data is added, or as shown in FIG. 16, re-ordered as data is removed.

Claim 62-63: See remarks for claim 3.

Claim 64: See remarks for claim 55.

Claim 70: See remarks for claim 39. The added phrase “..to thereby permit any buyer to select any offer to sell and any seller to select any offer to buy.” are merely recitations of intended usage for the physical interface and carry no patentable weight. Offers to buy (bids) are singled out by the hit bid process (col. 9, lines 1-10). From another perspective, the bids are singled out by reason that they separated from the offers (FIG. 5) and the offers are singled out by reason that they are separated from the bids (FIG. 5).

Claim 71: See remarks for claims 40-41.

Claim 72: Each graphical indicator includes information extracted from the digital information blocks, namely, the quantity of information blocks being sold for each bid value (see FIG. 4, lower left corner).

Claim 73: See remarks for claims 40-41.

Claim 74: See remarks for claim 43.

Claim 75: See remarks for claim 44.

Claim 76: In FIG. 4, the statistical information is best offer value and best bid value (lower right side). These are bidding and asking prices.

Claim 79: See remarks for claim 49.

Claim 80: See remarks for claim 50.

Claim 81: See remarks for claim 51.



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Claim 82: See remarks for claim 52.

Claim 83: See remarks for claim 53.

Claim 84: See remarks for claim 72.

Claim 85: See remarks for claim 55.

Claim 86: A graphic indicator generated by one user may indicated to that one user, or other users.

Claim 87: See remarks for claim 58.

Claim 89: See remarks for claim 55.

Claim 90: See remarks for claim 61.

Claim 91: See remarks for claim 3.

Claim 92: The digital information block can be removed from auction when it is sold.

Claim 93: See remarks for claim 55.

Claim 125: See remarks for claim 1.

Claim 127: The bids and offers can be overwritten by first removing them (such as by executing a trade, which would remove a bid matched to an offer) and then applying new bids and offers.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 32, 77, 78 and 126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al.

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Claims 2: Silverman et al. discloses trading instruments stored in a database (col. 2, lines 17-21). In relation to the apparatus, the content of the instrument is not functionally related to the substrate. It merely resides in the substrate for retrieval. In accordance with *In re Gulack* (703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) ), when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Accordingly, the inclusion of medical images as the descriptive material in the trading instrument will not distinguish from the prior art in terms of patentability, and is considered to have been obvious to one of ordinary skill in the art.

Claims 32: Computer access the subsets of data by requiring the user to submit a password is well known in art. It would have been obvious to one of ordinary skill in the art to modify Silverman et al. to require password protection of the data, as is well known in the art for the practice of data security.

Claim 77-78: Statistical values, such as the median values described with respect to claim 45, inherently require arithmetic calculations. Claims 77-78 are therefore obvious for the same reasons as those set forth for claim 45, since the performance of calculation of mean values inherently requires the performance of arithmetic calculations.

Claim 126: See remarks for claim 2.

Claims 59 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al. in view of Patterson, Jr. et al. (U.S. Patent 5,915,245).

Claims 59 and 88: Patterson et al. illustrates the usage of file names (IBM in FIG. 1) which are associated with tradable instruments. It would have been obvious to one of ordinary

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skill in the art to modify Silverman et al. to include file names with each block of graphical data in order to distinguish between different trading instruments, as taught by Patterson, Jr. et al.

Remarks

Applicant's arguments have been considered.

Application of the Silverman et al. Reference: Applicant's primary arguments are that:

- (1) The blocks of FIGS. 4 and 5 of Silverman et al. are separate and distinct elements; and that
- (2) The examiner cannot rely on two different reference figures to provide the same prior art teaching; (3) The blocks are not generated by users. All three arguments are incorrect.

With respect to point (1), FIGS. 4 and 5 are both illustrating blocks of information. The only distinction is that the central station book retains all the blocks while the keystation book is showing a subset (a selected number of) the blocks on the central station book (col. 10, lines 1-5). Silverman further states at col. 10, line 6 that the blocks of FIG 5 are copies of the blocks of FIG. 4, directly contradicting applicant's assertion that the blocks are somehow different in the two figures.

With respect to point (2), there is no known prohibition to an examiner relying on different figures of a reference to illustrate the same claim feature. In evaluating patentability under 35 USC 102, the question is not whether the examiner relies on different drawing figures, but whether or not the claimed features exist in any of the figures.

With respect to point (3) it is noted that the bids are not being made by the computers, but instead are being made by human buyers and sellers (col. 1, lines 18-26). The computer

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system does not actually generate those bids, but instead facilitates the viewing of the bids created by buyers and sellers.

Applicant's remaining arguments presented on pages 18-22 are blanket assertions of patentability without specific consideration of the cited portions of the Silverman reference. For example, the discussion of claims 1, 3, 9 and 10 assert the existence of claimed features allegedly not taught in Silverman, but only reference the abstract of Silverman, which was never relied upon or cited in making the rejection. The remaining arguments make blanket assertions of patentability without discussion of the citations from Silverman or the specific explanations made in support of the rejections under both 35 USC 102 and 35 USC 103.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell  
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Art Unit 2164